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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,110	12/17/2001	Alan Bernard Johnston	09710-1104	7754

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TECHNOLOGY LAW DEPARTMENT
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EXAMINER

POLLACK, MELVIN H

ART UNIT PAPER NUMBER

2145

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/016,110	Applicant(s) JOHNSTON, ALAN BERNARD	
	Examiner Melvin H Pollack	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/7/03</u> . | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

DETAILED ACTION

Claim Objections

1. Claim 29 is objected to because of the following informalities: claim 29 is a copy of claim 11, both dependent on claim 10. Appropriate correction is required. For the purposes of this examination, the examiner assumes claim 29 to be dependent on claim 28.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 4, 6, 7, 9, 10, 12, 13, 15, 16, 18, 19, 21, 22, 24, 25, 27, 28, 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Kozdon et al. (6,456,601).

4. For claim 1, Kozdon teaches a data communication system (abstract) for providing content transmission col. 1, line 1 – col. 3, line 45) upon placement of a call on hold (col. 3, lines 64-67), the system comprising:

- a. A server (Fig. 2, #40) configured to receive a message (col. 5, lines 33-44) from a first client (Fig. 2, #24) indicating the hold condition of the call with a second client (Fig. 2, #34); and
- b. Another server (Fig. 2, #10) configured to transmit the content stored therein to the second client in response to a request message from the server (col. 5, lines 45-53).

Art Unit: 2145

5. For claim 3, Kozdon teaches that the content includes at least one of music and messaging (col. 5, lines 50-51).
6. For claim 4, Kozdon teaches that the first client selects the content for transmission to the second client (col. 6, lines 3-5).
7. For claim 6, Kozdon teaches that the server sends a signaling message to the first client to instruct the first client to cease sending media to the second client (col. 4, lines 60-65).
8. Claims 7, 9, 10, and 12 are drawn to a method that effectively describes the activities undertaken by the hardware system as drawn in claims 1, 3, 4, and 6, respectively. It is well known in the art that the underlying method of a given system is functionally equivalent to said system. Therefore, since claims 1, 3, 4, and 6 are rejected, then claims 7, 9, 10, and 12 are also rejected for the reasons above. A teaching regarding the method/system equivalence is available upon request.
9. Claims 13, 15, 16, and 18 are drawn to a network device system that implements the method drawn in claims 1, 3, 4 and 6, respectively. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 1, 3, 4, and 6 are rejected, claims 13, 15, 16, and 18 are also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.
10. Claims 19, 21, 22, and 24 are drawn to a means system that implements the method drawn in claims 1, 3, 4, and 6, respectively. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 1, 3, 4, and 6 are rejected, claims 19, 21, 22, and 24 are also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

Art Unit: 2145

11. Claims 25, 27, 28, and 30 are drawn to a software system that implements the method drawn in claims 1, 3, 4, and 6, respectively. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 1, 3, 4, and 6 are rejected, claims 25, 27, 28 and 30 are also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2, 8, 14, 20, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozdon as applied to claims 1, 7, 13, 19, 25 above, and further in view of Anjum et al. (US 2001/0028654).

14. For claim 2, Kozdon teaches that the server is configured to perform a proxying function (col. 5, line 33) according to an application layer protocol (col. 5, lines 18-27), but does not expressly disclose that the protocol includes a Session Initiation Protocol. Anjum teaches a method (abstract) of providing telephony services (P. 1, Para 1 – P. 2, Para 15) in which functional application layers utilize SIP layers (P. 3, Para. 28-30). At the time the invention was made, one of ordinary skill in the art would have added SIP to Kozdon in order to enable dynamic service downloading (P. 4, Para. 39).

15. Claim 8 is drawn to a method that effectively describes the activities undertaken by the hardware system as drawn in claim 2. It is well known in the art that the underlying method of a

Art Unit: 2145

given system is functionally equivalent to said system. Therefore, since claim 2 is rejected, then claim 8 is also rejected for the reasons above. A teaching regarding the method/system equivalence is available upon request.

16. Claim 14 is drawn to a network device system that implements the method drawn in claim 2. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claim 2 is rejected, claim 14 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

17. Claim 20 is drawn to a means system that implements the method drawn in claim 2. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claim 2 is rejected, claim 20 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

18. Claim 26 is drawn to a software system that implements the method drawn in claim 2. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claim 2 is rejected, claim 26 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

19. Claims 5, 11, 17, 23, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozdon as applied to claims 1, 4, 7, 10, 13, 16, 19, 22, 25, 28 above, and further in view of Hazenfield (5,991,374).

20. For claim 5, Kozdon does not expressly disclose that the selected content is specified in a header of Session Initiation Protocol message from the first client to the server. Hazenfield teaches a method (abstract) of selecting and generating content for music-on-hold systems (col.

Art Unit: 2145

1, line 1 – col. 2, line 65) using such identification codes (col. 5, 18-40). At the time the invention was made, one of ordinary skill in the art would have added the selected content header to Kozdon to more efficiently remotely program the message playback (col. 1, line 65 – col. 2, line 15).

21. Claim 11 is drawn to a method that effectively describes the activities undertaken by the hardware system as drawn in claim 5. It is well known in the art that the underlying method of a given system is functionally equivalent to said system. Therefore, since claim 5 is rejected, then claim 11 is also rejected for the reasons above. A teaching regarding the method/system equivalence is available upon request.

22. Claim 17 is drawn to a network device system that implements the method drawn in claim 5. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claim 5 is rejected, claim 17 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

23. Claim 23 is drawn to a means system that implements the method drawn in claim 5. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claim 5 is rejected, claim 23 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

24. Claim 29 is drawn to a software system that implements the method drawn in claim 5. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claim 5 is rejected, claim 29 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

Conclusion

Art Unit: 2145

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

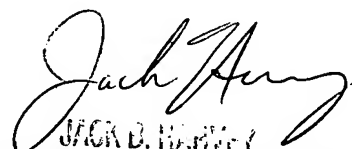
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (571) 272-3887.

The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
11 January 2005


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER